

1 R E M A R K S:

2

3 Several claims have been rewritten or amended and
4 others cancelled in order to hasten prosecution of the
5 case.

6 The requirement for restriction which has been made
7 in this case is respectfully traversed. With respect to that
8 requirement, it is submitted that with respect to the compounds
9 and their employment in pharmaceutical compositions and in
10 animal feedstuff compositions, it is submitted that dependent
11 concepts are involved since the compounds can be used for
12 either pharmaceutical compositions or for animal feedstuff
13 compositions. Clearly, dependent concepts are involved and
14 these dependent concepts should be included in a single
15 patent. It is submitted, therefore, that the requirement for
16 restriction between the inventions designated as Group I
17 and Group II are examinable together and that the requirement
18 which has been made should be withdrawn. Similarly, with
19 respect to the requirement for election of a single species,
20 it is submitted that the inventions of species 11-16 and
21 46 have a basic common structure in that they are all 1-
22 deoxynojirimycins and it would be utterly inappropriate to
23 have several patents issuing on a single invention differing
24 only in a substituent on the nitrogen atom. It is submitted
25 that the identical reasoning applies with respect to claim 10
26 and that analogous reasoning applies with respect to
27 generic claims 47, 48 and 49 as well as subgeneric claims
28 5-9. In the light of the above, it is submitted that the

1 requirement for restriction and the requirement for election
2 made in this case is inappropriate. Withdrawal of both
3 election and restriction requirements is most earnestly requested
4 Reconsideration is requested of the rejection of claims
5 1-10, 17-18, 24-32, 34-38 and 40-43 as allegedly obvious over
6 Ohata. With respect to the rejection, there is enclosed here-
7 with a declaration of Dr. Walter Puls, an expert in the art,
8 showing that the adjacent homolog of the Ohata compound
9 is unexpectedly superior to that prior art compound so that
10 it seems clear that the rejection which has been applied is
11 certainly no longer appropriate. This being the case, it is
12 submitted that the withdrawal of the rejection is clearly in
13 order.
14 Reconsideration is also requested of the rejection of
15 claim 45 (claims 19-23 having been cancelled) as allegedly
16 obvious under 35 USC 103 on Saeki et al, House and
17 March. With respect to this ground of rejection, it is
18 apparent that the only reference which might be deemed of
19 pertinence is Saeki and, with respect to the teachings of
20 Saeki, it is submitted that the course of the reaction
21 found obvious by the Examiner is in fact not so. It is
22 submitted that the person reasonably skilled in the art would
23 have expected to obtain a pyridine-derivative under the
24 process conditions and not a compound according to the invention.
25 This being the case, it is submitted that the rejection
26 which has been applied is certainly inappropriate with respect
27 to claim 45. Its withdrawal is anticipated.
28 In response to the rejection of claims 1-9, 17-32,
29
30

1 34-38, 40-43 and 45 under 35 USC 112, paragraphs 1 and 2,
2 attention is directed to the fact that in the claims, as
3 now presented, the terms "optionally substituted", "hydro-
4 carbon radical" "aromatic or heterocyclic radical",
5 "biprecursor", "substituents", "heteroatoms" and "monocyclic,
6 bicyclic or tricyclic radical" are no longer utilized. It
7 is to be noted that while the term "heterocyclic" is
8 still utilized, that substituent is further defined so that
9 its presentation is obviously appropriate. The alleged
10 "disagreements" in claim 1 is not found in generic claims 47-
11 49 and the composition and method claims now define an
12 effective amount for the intended uses. In view of the above,
13 it is submitted that the rejection of several claims on
14 formal grounds is certainly no longer appropriate. Its with-
15 drawal is expected.

16 The rejection of claims 1-9, 17-32, 34-38, 40-43 and
17 45 as allegedly involving an "improper joinder of inventions"
18 is respectfully traversed. It is submitted, initially,
19 that the rejection is clearly improper since although the
20 Examiner has indicated that the claims involved cover "patentably
21 distinct and separately classified" inventions, he has
22 failed to indicate exactly what these independent inventions
23 are. Absent such specific presentation, it is submitted that
24 the rejection is completely improper and indefinite since the
25 Examiner has not identified what the "improper joinder of
26 inventions" involves. Applicants are aware of the original
27 Markush decision in 1925 and applicants feels certain that
28 the Examiner is aware of many subsequent decisions with

1 respect to Markush practice. As has been indicated above,
2 the compounds involved in the present invention (and
3 the additional inventions involving compositions, methods
4 of manufacture and methods of use) all involve compounds
5 which are closely related in that they are all 3,4,5-
6 trihydroxypiperidines. Since the basic structure in each
7 is the same, it is submitted that the presence of varied
8 substituent groups does not provide the Examiner with the
9 opportunity to avoid examination on grounds of alleged
10 improper joinder. The rejection which has been applied is
11 utterly improper. Its withdrawal is expected.

12 The indicated allowability of claim 16 has been noted.
13 It is submitted that the allowance of all of the additional
14 specific claims as well as the subgeneric and generic claims
15 is in order.

16 A prompt and favorable response is earnestly solicited.

17 Respectfully submitted,

18 SPRUNG, FELFE, HORN, LYNCH & KRAMER

19 By _____
20 _____
21 _____
22 _____
23 _____
24 _____
25 _____
26 _____
27 _____
28 _____
29 _____
30 _____

Joseph G. Kolodny
Reg. No. 16,970

600 Third Avenue
New York, N.Y. 10016

(212) 661-0520